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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Takashi AOYAMA et al.

Serial No. 09/438,392

Filed: 12 November 1999

For: A CHEMICAL INDUCIBLE
PROMOTER USED TO
OBTAIN TRANSGENIC PLANTS
WITH A SILENT MARKER

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) Examiner: J. Zara
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) Group Art Unit: 1635
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#9/K.T.
7/31
ELECTION

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Office Action in the form of a Restriction Requirement mailed 2 July 2001, Applicants elect the claims of Group II (claims 14-37). This election is made with traverse.

The Office Action stated that the claims encompass six distinct inventions. Applicants do not disagree with the splitting of the claims of Groups I, IV, V and VI from the claims of Group II, but Applicants urge that the claims of Groups II and III represent a single invention and request that the claims of Group III be examined in addition to the claims of the elected Group II.

The claims of Group II are drawn to nucleic acids and vectors. The claims of Group III are drawn to transgenic plants comprising the nucleic acids and vectors of the Group II claims. The Office Action states that the inventions of Group II and III are unrelated and that inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects. The Office Action states that the "nucleic acids and vectors of Group II are not required to produce the transgenics of Groups III-VI". Applicants respectfully disagree with this statement.

There are two independent claims in Group II, these being claims 14 and 26. Claim 14 is drawn to a vector comprising a chemically inducible promoter. Claim 26 is drawn to a nucleic acid comprising a chemically inducible promoter. The claims of Group III comprise a single independent

claim which is claim 38. Claim 38 is drawn to a transgenic plant or transgenic plant cell comprising a vector wherein said vector comprises a chemically inducible promoter. It is apparent that claim 38 is simply a transgenic plant or plant cell comprising the vector of claim 14. Applicants fail to understand how the transgenics of Group III can be produced without the vector or nucleic acid of Group II. Applicants therefore respectfully assert that the statement in the Office Action that the transgenics of Group III can be produced without the nucleic acids or vectors of the claims of Group II is in error. There is no invention in making a transgenic plant *per se*. The invention is based in the specific nucleic acid or vector which the transgenic plant comprises.

In view of the above statements, Applicants urge that the claims of Groups II and III comprise a single invention and it is requested that all of the claims of Groups II and III be examined in this application.

Respectfully submitted,



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